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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,398	01/25/2001	Eric Edwards	80398.P399	6879
8791	7590	07/08/2004	EXAMINER HAYES, JOHN W	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD, SEVENTH FLOOR LOS ANGELES, CA 90025			ART UNIT 3621	PAPER NUMBER

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,398

Applicant(s)

EDWARDS ET AL.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-15, 17-21 and 23-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 2-15, 17-21 and 23-35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 25 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Status of Claims

1. Applicant has amended claims 2, 6-11, 13-15, 17-21, 23-27, added new claims 28-35 and canceled claims 1, 16 and 22. Thus, claims 2-15, 17-21 and 23-35 remain pending and are presented for examination.

Response to Arguments

2. Applicant's arguments filed 26 April 2004 have been fully considered but they are not persuasive.

3. With respect to claims 2, 18 and 24, applicant argues that Hulls does not disclose receiving a query from the seller for a request from the buyer for digital content having user-specified criteria. Examiner respectfully disagrees and submits that Hulls discloses that the seller submits a search having user specified criteria for an item which is also the user specified criteria requested by the buyer. The system as disclosed by Hulls receives the query from the seller and matches the seller specified criteria with buyer specified criteria to find a match. In other words, the seller is submitting a query to find buyers who have submitted a request for an item that the buyer desires to purchase. The system performs the search and finds buyers requests having the criteria that matches the sellers query and allows the seller to contact the buyer when a match is found (Figures 24-26; 0035-0037). Figure 25 specifically shows that the seller submitted information is treated as a query in which buyers having similar criteria matching the sellers criteria are found.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 2-15, 17-21 and 23-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al, U.S. Patent Application Publication No. US 2003/0163431 A1 in view of Hulls et al, U.S. Patent Application Publication No. US 2001/0032229 A1.

As per **Claims 2-3 and 28-29**, Ginter et al disclose a computerized method and system for brokering digital content between a buyer and a seller on a public submission content library comprising:

- performing a search for content using user-specified criteria (0174; 0221; 0931; 2333; 2383; 2385; 2396; 2427);
- receiving a bid from the buyer for content found by the search (2146-2147; 2152; 2173-2176; Figures 76A and 76B; 2179)
- sending the bid to the seller (2175-2176; 2179);
- receiving a response to the bid from the seller (2175-2176; 2179);
- receiving an offer from the seller of content (2175-2176; 2179);
- sending the offer to the buyer (2175-2176; 2179); and
- releasing the content to the buyer if agreement is reached between the buyer and the seller (2175-2176; 2179)

Ginter et al disclose wherein a buyer searches for content having user-specified criteria (0174; 0221; 0931; 2385; 2396; 2427), however, fail to specifically disclose receiving a query from the seller for a request from the buyer having the user-specified criteria. Hulls et al disclose that the seller submits a search having user specified criteria for an item which is also the user specified criteria requested by the buyer. The system as disclosed by Hulls receives the query from the seller and matches the seller specified criteria with buyer specified criteria to find a match. In other words, the seller is submitting a query to find buyers who have submitted a request for an item that the buyer desires to purchase. The system performs the search and finds buyers requests having the criteria that matches the sellers query and allows the seller to contact the buyer when a match is found (Figures 24-26; 0035-0037). Figure 25 specifically shows that the seller submitted information is treated as a query in which buyers having similar criteria matching the sellers criteria are found. It would have been obvious to one of ordinary skill

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in the art at the time of applicant's invention to modify the method of Ginter et al and include not only the ability for buyers to search for sellers who are offering the products that buyer desires, but also, the ability for sellers to search for buyers who desire the products the seller is offering as taught by Hulls et al. The motivation, as suggested by Hulls et al, would be to implement a system whereby a marketplace is created in which both buyers and sellers are able to locate each other and undertake and complete independent commercial transactions (0011).

As per **Claims 4 and 30**, Neither Ginter et al nor Hulls et al specifically disclose wherein the offer comprises a sample of the content. Official Notice is taken that offering a sample of content to a buyer was well known in the art at the time of applicant's invention and was typically carried out so that the buyer could review the sample in order to determine if he/she wanted to purchase the entire file or content. Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the methods of Ginter et al and Hulls et al and offer the buyer a sample of content in order to enable the buyer to decide for or against the purchase of the content.

As per **Claim 5**, Ginter et al further disclose wherein releasing the content to the buyer comprises:

- receiving the content from the seller (Figures 2 and 77-80 and associated text);
- sending the content to the buyer (Figures 2 and 77-80 and associated text).

As per **Claim 6**, Ginter et al further disclose receiving the content from the seller prior to the search (2377-2391; Figure 78).

As per **Claim 7**, Ginter et al further disclose wherein the response from the seller is a counteroffer and further comprising:

- sending the counteroffer to the buyer (2175-2176; 2179); and
- receiving a response to the counteroffer from the buyer (2175-2176; 2179).

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As per **Claim 8**, Ginter et al further disclose receiving payment for the content from the buyer and validating the payment (0161; 0166; 0212; 0224; 0441; 1924; 2083; 2201; 2410).

As per **Claims 9 and 31**, Ginter et al further disclose watermarking the content and sending the watermarked content to the buyer (0220; 0381; 2354).

As per **Claims 10, 20 and 26**, Ginter et al fail to specifically disclose soliciting a rating from the buyer and seller. Hulls et al disclose soliciting a rating from the buyers and sellers (Figures 10, 13 and 19; 0042 and 0046). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ginter et al and include a rating system for rating the buyers and sellers. It was well known in the art at the time of applicant's invention that soliciting rating information for buyers and sellers that use a system for carrying out transactions provides very useful information. This enables the buyers and sellers to determine whether or not they want to engage in a transaction with a particular party based upon their rating.

As per **Claims 11 and 32**, Ginter et al further disclose

- tracking use of the content by the buyer in accordance with restrictions placed on the content by the seller (0078; 0091; 0140; 0173; 0185; 0198; 0215; 0228; 0445; 0696; 1228); and
- notifying the seller if the use of the content by the buyer violates the restrictions (0163; 0215; 0252; 0445; 0696; 1587; 2201; 2303).

As per **Claims 12 and 33**, Ginter et al further disclose notifying the buyer if the use of the content by the buyer violates the restrictions (0163; 0215; 1509; 1587; 2303).

As per **Claims 13-14 and 34**, Ginter et al further disclose receiving compensation for brokering services from the buyer or seller (224; 405; 426; 2200; 2470; 2476; 2478; 2480; 2482; 2490; 2495).

As per **Claims 15 and 35**, Ginter et al further disclose receiving revenue for advertisements displayed to the buyer and seller (202; 213; 228; 1152; 1223; 2221; 2415).

As per **Claims 18 and 24**, Ginter et al disclose a computerized server and a computer readable medium having computer-executable instructions comprising:

- a processing unit (Figures 7-9);
- a search function executed from the memory to cause the processing unit to perform a search for content having user-defined criteria (Figure 78; 0174; 0221; 0931; 2333; 2383; 2385; 2396; 2427); and
- a financials function executed from the memory to cause the processing unit to manage negotiations and manage a payment between a buyer and a seller of content found by the search function (Figure 78; 2175-2176; 2179; Figures 76A and 76B).

Ginter et al disclose wherein a buyer searches for content having user-specified criteria (0174; 0221; 0931; 2385; 2396; 2427), however, fail to specifically disclose receiving a query from the seller for a request from the buyer having the user-specified criteria. Hulls et al disclose that the seller submits a search having user specified criteria for an item which is also the user specified criteria requested by the buyer. The system as disclosed by Hulls receives the query from the seller and matches the seller specified criteria with buyer specified criteria to find a match. In other words, the seller is submitting a query to find buyers who have submitted a request for an item that the buyer desires to purchase. The system performs the search and finds buyers requests having the criteria that matches the sellers query and allows the seller to contact the buyer when a match is found (Figures 24-26; 0035-0037). Figure 25 specifically shows that the seller submitted information is treated as a query in which buyers having similar criteria matching the sellers criteria are found. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Ginter et al and include not only the ability for buyers to search for sellers who are offering the products that buyer desires, but also, the ability for sellers to search for buyers who desire the products the seller is offering as taught by Hulls et al. The motivation, as suggested by Hulls et al, would be to implement a system whereby a marketplace is

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created in which both buyers and sellers are able to locate each other and undertake and complete independent commercial transactions (0011).

As per Claims 17 and 23, Ginter et al further disclose wherein the financials function further operates to cause the processing unit to manage a payment from the buyer to the seller (0161; 0166; 0212; 0224; 0441; 1924; 2083; 2201; 2410).

As per Claims 19 and 25, Ginter et al further disclose a watermarking function executed from the memory to cause the processing unit to watermark the content (0220; 0381; 2354).

As per Claims 21 and 27, Ginter et al further disclose

- a tracking function executed from the memory to cause the processing unit to track use of the content by the buyer in accordance with restrictions placed on the content by the seller (0078; 0091; 0140; 0173; 0185; 0198; 0215; 0228; 0445; 0696; 1228); and further to
- notify the seller if the use of the content by the buyer violates the restrictions (0163; 0215; 0252; 0445; 0696; 1587; 2201; 2303).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

8. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

9. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Murcko, Jr. discloses a transaction system between buyers and sellers and teaches that sellers have the ability to search for relevant buyer information and make offers to the buyers.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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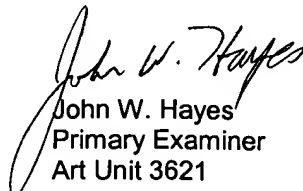
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.


John W. Hayes
Primary Examiner
Art Unit 3621

June 30, 2004